



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/864,486	05/24/2001	Javier Menendez Diaz	976-9	2985
23869	7590	09/08/2004	EXAMINER	
HOFFMANN & BARON, LLP 6900 JERICO TURNPIKE SYOSSET, NY 11791			LAMBERTSON, DAVID A	
			ART UNIT	PAPER NUMBER
			1636	

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/864,486

Applicant(s)

DIAZ ET AL.

Examiner

David A. Lambertson

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-26 is/are pending in the application.
- 4a) Of the above claim(s) 10 and 12 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7, 9, 14, 15, 17-21, 23 and 24 is/are allowed.
- 6) ☒ Claim(s) 16, 22, 25 and 26 is/are rejected.
- 7) ☒ Claim(s) 6, 8, 11 and 13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1636

DETAILED ACTION

Election/Restrictions

Applicant's election of Group I (claims 6-9, 11 and 13-26) in the reply filed on June 28, 2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 6-26 are pending in the instant application. Claims 10 and 12 are withdrawn from consideration. Claims 6-9, 11 and 13-26 (with respect to nucleic acid fragments comprising SEQ ID NO: 1 (including those combining SEQ ID NO: 1 and SEQ ID NO: 2) are under consideration in the instant application.

Priority

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in the instant Application. It is noted that a translation of the foreign document has not been provided.

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:
It does not identify the mailing address of each inventor. A mailing address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The mailing address should include the ZIP Code designation. The

Art Unit: 1636

mailing address may be provided in an application data sheet or a supplemental oath or declaration. See 37 CFR 1.63(c) and 37 CFR 1.76.

It is noted that the supplemental response filed December 12, 2003 indicating the mailing addresses of the inventors and signed by the attorney of record is not a substitute Oath/Declaration. Applicant is required to provide a new Oath/Declaration signed by the inventors and providing all of the necessary information.

Specification

The substitute specification filed August 28, 2001 is acknowledged.

Claim Objections

Claims 6, 8 and 13 are objected to because of the following informalities: the claims refer to non-elected subject matter. Specifically, the claims remain directed in part to nucleic acids comprising SEQ ID NO: 2 in the absence of SEQ ID NO: 1 (i.e., the claims are directed to nucleic acids comprising SEQ ID NO: 1 and/or SEQ ID NO: 2). It would be remedial to remove the term "or" from the claim to obviate the non-elected subject matter. It is additionally noted that if such an amendment is made, an issue regarding a failure to further limit may arise for claims that depend from these claims (i.e., claim 9 will be broader in scope than its independent claim 8). Appropriate correction is required.

Claim 11 is objected to because of the following informalities: the claim contains an acronym that is not identified by "spelling out" the terms within the acronym. In the instant case, the acronym ICL appears to stand for isocitrate lyase. It would be remedial to indicate this

Art Unit: 1636

term in parenthesis upon the first appearance of the acronym in the claims. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16, 22, 25 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16 recites the phrase “a dextranase encoding a gene from *P. minioluteum*.” It is unclear if the gene is encoded within the coding sequence of a dextranase (i.e., a cryptic or alternatively splicing gene), or if the gene is what codes for the dextranase. If the latter were intended, it would be remedial to substitute the phrase “a gene encoding a dextranase from *P. minioluteum*.”

Regarding claim 22, the phrase “preferably” renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. It would be remedial to remove the term “preferably” from the claim.

Claim 25 (and its dependent claims) is rejected because the claim contains multiple periods. Specifically, there are periods after each lower case Roman numeral. This is indefinite because a period indicates the end of the sentence, thus it is unclear if the method should end after the first (or after which) period. It would be remedial to remove the periods and recite the lowercase Roman numerals parenthetically.

Art Unit: 1636

Allowable Subject Matter

Claims 7, 9, 14, 15, 17-21, 23 and 24 are allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A. Lambertson whose telephone number is (571) 272-0771. The examiner can normally be reached on 6:30am to 4pm, Mon.-Fri., first Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel, Ph.D. can be reached on (571) 272-0781. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David A. Lambertson, Ph.D.
AU 1636


JAMES KETTER
PRIMARY EXAMINER